

18. pivot points of the respective walking beams are between the respective front and rear roller members.

19. (Amended) A roller assembly for compacting road surfaces during paving operations, the roller assembly comprising the following:

a generally rectangular steel frame member;

five front roller members;

five rear roller members; and

five walking beams pivotably connected to the frame member at respective pivot points, each of the walking beams connecting one of the front roller members with a respective one of the rear roller members such that the pivot points of the respective walking beams are between the respective front and rear roller members.

20. (Amended) A method of compacting paving material distributed on a road surface, the method comprising the following steps:

providing a roller assembly comprising a frame member, a plurality of front roller members, a plurality of rear roller members corresponding in number to the plurality of front roller members, and a plurality of walking beams pivotably connected to the frame member at respective pivot points, each of the walking beams connecting one of the front roller members with a respective one of the rear roller members such that the pivot points of the respective walking beams are between the respective front and rear roller members;

connecting the roller assembly to a tow vehicle; and

towing the roller assembly over the paving material.

#### Remarks

Claims 1 through 20 stand rejected.

Claims 1, 12, and 19 have been amended to more particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

Claims 1 through 20 remain in the application.

This amendment is made to place the application into condition for allowance. In the alternative, this amendment is made to place the application into better form for consideration on appeal.

Attached hereto, identified as "Version with markings to show changes made", is a marked-up version of the changes made to the claims by the current amendment.

Reconsideration and re-examination of the application are respectfully requested.

#### THE §103 REJECTION

Claims 1-4, 10-14, and 19 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 1,238,497 to Connelly. Claims 5-7, 15-17, and 20 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 1,238,497 to Connelly in view of U.S. Patent No. 1,320,533 to Cull. These rejections, insofar as they may be applied to the claims as amended, are respectfully traversed. Applicant respectfully submits that, for the reasons that follow, the Examiner has failed to establish a prima facie case for obviousness.

In Graham v. John Deere Co., 383 U.S. 1 (1966), the Supreme Court indicated that "under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level ordinary skill in the art resolved." 383 U.S. 1 at 17.

#### SCOPE AND CONTENT OF THE PRIOR ART

**U.S. Patent No. 1,238,497 to Connelly** is directed to an apparatus for leveling and tamping concrete road beds wherein front and rear tamping rollers are connected by front roll bearing sections are rigidly connected to rear roll bearing

sections (Connelly Page 1, lines 103-108). Short links connect the front roll bearing section to the supporting members (Connelly Page 1, lines 96-109), and links connect the rear roll bearing sections to the drag (Connelly Page 2, lines 16-24). There are no pivots between the front and rear tamper rollers.

**U.S. Patent No. 1,320,533 to Cull** deals with a road roller in which pairs of rollers are rigidly connected to I-beams, which are in turn pivotably connected to a frame via pintles mounted in front of the wheels (Cull Page 2, lines 22-32 and FIG. 2). There are no pivots between the front and rear rollers.

**DIFFERENCES BETWEEN THE PRIOR ART AND THE  
CLAIMS AT ISSUE**

Claims 1 through 20 recite structure and function that are not found in the references of record. Each of these claims requires a plurality of walking beams pivotably connected to the frame member such that the pivot points of the respective walking beams are between the respective front and rear roller members (Lines 8-10 of Claims 1, 13, and 20).

These features are lacking entirely from each of the cited references, and provide advantages in operation and maintenance that cannot be achieved with either of the configurations shown in Connelly and Cull.

**THE LEVEL OF ORDINARY SKILL IN THE ART**

A person of ordinary skill in the art would never be motivated to modify the double outside pivots of Connelly with the single forward pivot of Cull to arrive at the center-pivot walking beam apparatus positively recited in Applicants' claims.

Each of Applicant's claims, as amended, requires structure and function that is not present in any permissible combination of the cited references.

Applicant submits that the question under §103 is whether the totality of the prior art would collectively suggest the claimed invention to one of ordinary skill in this art. In *re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). The answer to this question with respect to Applicant's claimed invention is clearly "no".

It is insufficient that the prior art disclosed the components of the claimed device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1988). Individual references cannot be "employed as a mosaic to recreate a facsimile of the claimed invention." *Northern Telecom Inc. v. Datapoint Corp.*, 15 U.S.P.Q. 2d 1321, 1323 (Fed. Cir. 1990).

Even assuming that one of ordinary skill in the art would somehow have combined the references applied by the Examiner, the resultant combination would still lack critical features positively recited in the amended claims.

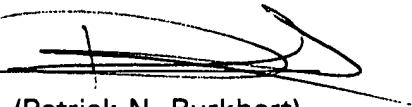
With the analysis of the deficiencies of the applied references in mind as enumerated above, there is no reason or suggestion in the evidence of record as to why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, prima facie obviousness has not been established.

The Examiner has failed to meet the test for obviousness as set forth in *Graham v. John Deere Co.* Withdrawal of the §103 rejection is in order, and therefore respectfully requested.

In view of the foregoing remarks and amendments, Applicants respectfully submit that claims 1 through 20, as amended, define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application, and to pass the application to issue.

Respectfully submitted,  
(Allan Otto et al.)

By

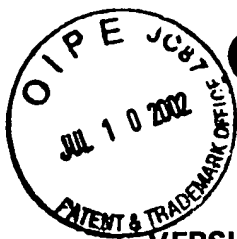


(Patrick N. Burkhart)

Reg. No. 33,352

July 2, 2002  
(406 862-1187)





COPY OF PAPERS  
ORIGINALLY FILED

7

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (Amended) A roller assembly comprising the following:

- a frame member;
- a plurality of front roller members;
- a plurality of rear roller members corresponding in number to the plurality of front roller members; and
- a plurality of walking beams pivotably connected to the frame member at respective pivot points, each of the walking beams connecting one of the front roller members with a respective one of the rear roller members such that the pivot points of the respective walking beams are between the respective front and rear roller members.

13. (Amended) A roller assembly for compacting road surfaces during paving operations, the roller assembly comprising the following:

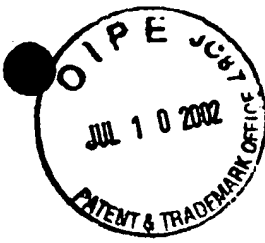
- a generally rectangular steel frame member;
- five front roller members;
- five rear roller members; and
- five walking beams pivotably connected to the frame member at respective pivot points, each of the walking beams connecting one of the front roller members with a respective one of the rear roller members such that the pivot points of the respective walking beams are between the respective front and rear roller members.

20. (Amended) A method of compacting paving material distributed on a road surface, the method comprising the following steps:

- providing a roller assembly comprising a frame member, a plurality of front roller members, a plurality of rear roller members corresponding in number to the plurality of front roller members, and a plurality of walking beams pivotably connected to the frame member at respective pivot points, each of the

S/N:09/815,587  
Case: 10003583-1  
Amendment A

a



8

walking beams connecting one of the front roller members with a respective one of the rear roller members such that the pivot points of the respective walking beams are between the respective front and rear roller members;

connecting the roller assembly to a tow vehicle; and  
towing the roller assembly over the paving material.

COPY OF PAPERS  
ORIGINALLY FILED

---

S/N:09/815,587  
Case: 10003583-1  
Amendment A

a